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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,276	12/21/1999	Jean-Baptiste Dumas Milne Edwards	GENSET.025CPI	7217

7590 01/14/2002

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EXAMINER

ZHOU, SHUBO

ART UNIT PAPER NUMBER

1631

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DATE MAILED: 01/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,276

Applicant(s)

EDWARDS ET AL.

Examiner

Shubo "Joe" Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,10-13,17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 1,4-8,10-13,17,19-21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' election of Group II (original claim 3 and newly added claims 22-23), drawn to polypeptide and SEQ ID NO:831, in Paper No. 9, filed 12/18/01, is acknowledged. Because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicants request that the newly added claim 24, drawn to ~~claim 24~~ a method of producing a polypeptide join Group II to be co-examined. This request is considered and is not deemed be be grantable because claim 24 is not drawn to the elected invention but rather to the non-elected Group IV, drawn to method of making polypeptide (see page 3 of the previous Office action, mailed 9/25/01).

Applicants' amendment of canceling claims 2-3, 9, 14-16, and 18, and adding claims 22-24 is also acknowledged and entered.

Accordingly, claims 1, 4-8, 10-13, 17, and 19-24 are currently pending, but only claims 22-23 are under examination, and the remaining claims are withdrawn from further consideration as being drawn to non-elected inventions.

Priority

It is brought to applicants' attention that for the purpose of examination, priority has not been granted to the claimed applications 09/057,719, filed 4/9/98, and 09/069,047, filed 4/28/98 for the elected invention because the claimed sequences are

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not adequately disclosed in the applications. Prior art published after the claimed provisional application but before the filing date of the instant application may have been cited in this Office action. Applicants are requested to provide evidence that the elected invention is indeed disclosed in the claimed provisional application if they wish to contest the citation of the intervening prior art.

Specification

The specification is objected to because of the following:

It is noted that a PTO-948 was mailed with Paper No. 5 on 9/25/01. Applicants were notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Pursuant to the above notification, applicants are required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action. In Paper No. 9, applicants state that drawings with such correction are provided to the Office, however, there are no such drawings received by the Office. Applicants are still required to submit drawing corrections within the time period set for responding to this Office action.

Claim Rejections-35 USC § 101 and § 112

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, Written Description Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

See also the MPEP at §§ 2107 - 2107.02.

Claims 22-23 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility.

The claimed polypeptides are not supported by a specific asserted utility because the disclosed uses of these polypeptides are generally applicable to any polypeptides. For example, the specification states that the polypeptides "may be therapeutically important" and thus "may be useful in treating and controlling a variety of human conditions", etc. (page 9, first paragraph of the specification). These possible uses are not specific because the specification does not disclose specific human conditions and never connects any of the specifically disclosed sequences to any particular or specific utility. This wishlist-like desire for a utility for the claimed sequences seems to fall short of a readily available utility.

Further, the claimed polypeptides are not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, with regard to the aforementioned possible utility in therapy for human conditions, it is necessary to conduct research to functionally characterize the protein to elucidate biochemical/biological functions/pathways and to study the associations of the polypeptide with any human conditions. The apparent need for such research clearly indicates that the protein and/or its function is not disclosed as to a currently available or substantial utility. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case none of the proteins that are to be produced as final products resulting from processes involving claimed nucleic acid have asserted or identified specific and substantial utilities.

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Please note, because the claimed invention is not supported by a specific and substantial asserted utility for the reasons set forth above, credibility has not been assessed.

Neither the specification as filed nor any art of record discloses or suggests any property or activity for the nucleic acid and/or protein compound(s) such that another non-asserted utility would be well established for the nucleic acid compounds.

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-23 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Conclusion

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG

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61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D.



Patent Examiner

MICHAEL BORIN, PH.D.
PRIMARY EXAMINER

